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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,823	04/12/2001	Li Li	03384.0133-01	2661

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EXAMINER	
HYUN, SOON D	

ART UNIT	PAPER NUMBER
2663	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,823	LI ET AL.	
	Examiner	Art Unit	
	Soon D Hyun	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,8,9,11-16,18,20,21 and 23-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,8,9,11-16,18,20,21 and 23-64* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05/31/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6, 8, 9, 11-16, 18, 20, 21, and 23-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,243,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-46 of U.S.

Patent Number 6,243,383 encompass the limitations of claims 1-4, 6, 8, 9, 11-16, 18, 20, 21, and 23-34 of the instant application. Moreover, omission of a reference element whose function is not needed would be obvious to one or ordinary skill in the art. It is well settled that the omission of an element(s) and its functions is an obvious expedient if the remaining element perform the same function as before In re Karlson, 163 USPQ 184 (CCPA 1963). Also note Ex parte Rainu,168 USPQ 375 (Bd. App. 1969).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 6, 8, 9, 13, 14, 18, 20-21, 25-27, 30-32, and 35-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U.S. Patent No. 5,930,257) in view of Applicant Admitted Prior Art (AAPA)

Regarding claims 1, 2, 13, 14, 25, 26, 30, and 31, Smith et al (Smith) discloses a method for routing a call across a first ATM network (an ATM network 407 in FIG. 4 connected to port 201 in FIG. 2, see col. 4, lines 22-42), toward a second ATM network (the second ATM network is connected to one of ports 202-207 in FIG. 2 is not clearly shown, but it would have been obvious to one having ordinary kill in the art to connect a second ATM network to a port 202 in FIG. 2, see col. 2, lines 63-65), the call having an associated signaling message (an Ethernet packet generated by Ethernet 410, see col. 5, line 31) specifying a destination address (an destination network address, col. 5, line 19 and used as network-level address as in claim 10) of the second network, the method comprising the steps of:

translating the destination address into a local address (VC1), the VC1 is a address format of the first ATM network and is assigned as a local address by ATM IF of Ethernet 410 (an resolution server as in claim 13) when the destination address is another network, see col. 4, lines 56-64);

repacking the signaling message with the local address as a routing address (the Ethernet packet is segmented into ATM cells with the VC1 address, see col. 5, lines 31-39);

routing the call through the first ATM network using the local address; and

repacking the signaling message with the destination address as the routing address (ATM interface 425 reassembles the cells with VC1 into the Ethernet packet having the destination address and Routing engine 430 handles the destination address as the routing address to forward the call to the second network, see col. 5, lines 15-23).

However, Smith does not explicitly teach that the second ATM network has a address format different from the address format of the first ATM network.

The AAAP (Specification page 1, lines 5-20), ATM networks having different address formats are used in the private and public networks. Those of skill in the art would have been motivated by the AAAP to connect the second ATM network that has an address format different from the first ATM network such that the two ATM networks having different address formats could communicate each other as long as associated ATM interfaces are provided.

Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the second ATM network into the system of Smith.

Regarding claims 6 and 18, Smith does not explicitly teach the conversion algorithm to obtain the local address, but a process (an algorithm) for the translation of the destination address is inherently required.

Regarding claim 8, 20, 27, and 32, Smith further discloses that the destination address transparently across the first network (col. 5, lines 31-37).

Regarding claims 9 and 21, refer to claims 1 and 13, Smith teaches that a destination address (the destination address is inherently required in the Ethernet

protocol and used as a user-level address as in claim 10) in the Ethernet packet header specifies an end system beyond second network, i.e., destination of end system (terminal) of a LAN network connected to the second ATM network.

Regarding claims 35, 45, and 55, refer to the discussion for claim 1. The steps of storing the destination address and associating the call with the stored destination address are inherently required in Smith, because the system uses the method of packet segmentation and reassembling.

Regarding claims 36, 46, and 56, refer to claim 35. The destination address is stored (pushed) into a memory (a stack).

Regarding claims 37, 47, and 57, it is obvious to one having ordinary skill in the art to use LIFO (a last in first out stack) or FIFO (a first in first out stack) based on the order of writing/reading into/from the memory.

Regarding claims 38, 43, 48, 53, 58, and 63, it is inherently required to remove or popping (erase or read-out) the destination address from the memory when the destination address in the memory is not in further use.

Regarding claims 39, 49, and 59, refer to claims 1, 35 and 38.

Regarding claims 40, 50, and 60, refer to claim 8.

Regarding claims 41, 51, and 61, refer to claim 1, a third ATM net work is not clearly shown, but it is obvious to one having ordinary skill in the art to connect the third ATM network that is connected to a port 203 in FIG. 2, (see col. 2, lines 63-65), wherein an additional local address in the address format of the third ATM network is determined.

Regarding claims 42, 52, and 62, Smith further teaches that the port 203 (same structure of port 201 in FIG. 4) is processing the steps of the repacking and routing as recited in claim (col. 5, lines 15-23).

Regarding claims 44, 54, and 64, Smith further teaches that the step of translating occurs at the egress side of the first network (at ATM IF).

Allowable Subject Matter

6. Claims 3, 4, 11, 12, 15, 16, 23, 24, 28, 29, 33, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and the double patenting rejection is cleared

7. The following is a statement of reasons for the indication of allowable subject matter.

The prior art of record fails to teach the step of querying the address translation database populated with the address interface identifier pair to obtain the local address as recited in claims 3, 4, 15, and 16.

The prior art of record further fails to teach the step (means) of inserting the local address into the first signaling message parameter as recite in claims 11, 23, and 28.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Soon D Hyun whose telephone number is 571-272-3121. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on 571-2713139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Hyun
04/05/2005

RICKY NGO
PRIMARY EXAMINER

4/11/05